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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/236,402	05/02/1994	RICHARD T. DEAN	DITI-107	3548

7590 04/26/2004

FISH AND RICHARDSON, P.C.  
45 ROCKEFELLER PLAZA  
SUITE 2800  
NEW YORK, NY 10111

EXAMINER

RUSSEL, JEFFREY E

ART UNIT	PAPER NUMBER
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1654

DATE MAILED: 04/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

08/236,402

Applicant(s)

DEAN ET AL.

Examiner

Jeffrey E. Russel

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 18 March 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 18 March 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☒ Applicant's reply has overcome the following rejection(s): See attachment.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attachment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None.Claim(s) objected to: None.Claim(s) rejected: 1-3,6-8,11-17,19-21 and 38.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

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1. The proposed new claim for priority is a new issue requiring further consideration and search. Further, the proposed claim for priority is not in single sentence format.

The proposed amendment to the paragraph beginning at page 12, line 3, of the specification, last line of the proposed amended paragraph, raises a new issue requiring further consideration because the proposed amendment omits “(SEQ ID NO:4)” without appropriate marking under 37 CFR 1.121(b) and in violation of 37 CFR 1.821(d).

The proposed new limitation for claim 1 is a new issue requiring further consideration and search.

2. The objection set forth in section 2 of the final Office action is maintained. The issue is whether or not the declaration refers to an amendment containing new matter. Whether the amendment has been entered or canceled is not relevant to the objection.

3. The terminal disclaimer filed March 18, 2004 is approved and overcomes the obviousness-type double patenting rejection set forth in section 5 of the final Office action.

4. The rejection over Dean et al (U.S. Patent No. 5,443,815) is maintained. As set forth in Land and as acknowledged by Applicants, any difference in inventorship or authorship prima facie satisfies the statutory requirement that the application be filed “by another”. The burden is on Applicants to provide evidence that the subject matter from the reference being applied is not actually by another but was invented by the Applicants. Neither Applied Materials nor Purdue, cited by Applicants, holds that the Office can sua sponte waive this requirement that Applicants provide such evidence. In Applied Materials, the court found that the invention claimed in the later-filed application (i.e. the ‘313 patent) was “fully disclosed” in the earlier-filed application (i.e. the ‘712 patent) and therefore the earlier-filed application was not actually prior art. 15

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USPQ2d at 1818. This is in contrast to the instant fact situation, where the invention claimed in this later-filed application is not fully disclosed in the earlier-filed application. See section 6, first paragraph, of the Office action mailed September 15, 2003. Applied Materials in no way contradicts Land. This is emphasized by the district court in Purdue, which in the paragraph immediately preceding the one cited by Applicants states “It is unlikely that the Federal Circuit intended in *Applied Materials* to overrule that proposition, given that the *Applied Materials* decision cites *Land* with approval and makes no mention of reconsidering *Land*.” 55 USPQ2d at 1181. On appeal, the CAFC in Purdue pointed out that the inventors of the later-filed application submitted evidence of earlier conception and reduction to practice in order to antedate the earlier-filed application. 57 USPQ2d at 1651. There is no suggestion in Purdue that a difference in inventorship between two patents does not satisfy the “by another” requirement of 35 U.S.C. 102(e).

For analogous reasons, the rejection based upon the WO Patent Application 93/10747 is maintained. The declaration by Inventor Dean filed July 28, 2003 does not satisfy the evidentiary burden required of Applicants for the reasons set forth in section 18, second paragraph, of the final Office action.

The rejection based upon Dean et al (U.S. Patent No. 5,849,260) is maintained. The proposed claim for priority based upon application serial no. 07/886,752 is a new issue requiring further consideration and/or search and will not be entered. Further, Applicants have made no attempt to analyze the proposed priority claim in order to determine whether the instant claims are entitled to the benefit of the filing date of the '752 application. Again, the declaration by Inventor Dean filed July 28, 2003 does not show that Dean et al '260 was not by another, for the

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reasons set forth in the final Office action. To the extent that Applicants may be implying that this declaration should be considered under 37 CFR 1.131, the Dean declaration lacks several of the evidentiary requirements of such a declaration. For example, the Dean declaration does not list all of the inventors of the instant claimed invention, the Dean declaration is not signed by all of the inventors of the instant claimed invention, the Dean declaration does not state that the acts relied upon to antedate the reference were carried out in this country, and the Dean declaration does not explicitly allege a date of invention prior to that of Dean '260. There is also an issue of whether a declaration under 37 CFR 1.131 can be relied upon to antedate a U.S. patent which has been terminally disclaimed by the instant application, i.e. where the patent and the application claim the same invention.

The rejection over the WO Patent Application 93/17719 is maintained. The reference is "by another" for the reasons of record, and this presumption is not by rebutted by the Dean declaration for the reasons of record.

The rejection based upon Dean (U.S. Patent No. 6,017,510) set forth in section 12 of the final Office action is withdrawn, because the patent is not the equivalent of the WO Patent Application 93/17719.

The rejection based upon Dean (U.S. Patent No. 5,552,525) set forth in section 13 of the final Office action is withdrawn for the reasons given in Applicants' response at page 22, lines 8-20.

The rejection based upon Zamora (U.S. Patent No. 5,556,609) is maintained. It is settled case law that "comprising" language permits the presence of any additional components. See

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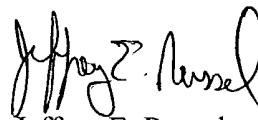
MPEP 2111.03. Such additional components do not have to be supported by Applicants' specification in order to be embraced within the scope of the claim language.

The rejections based upon the WO Patent Application 90/10463 and upon the WO Patent Application 90/10463 in view of Fritzberg et al (U.S. Patent No. 4,965,392) are maintained for the reasons of record.

The rejection based upon the Plank et al article is maintained. As noted above, the proposed limitation for claim 1 will not be entered. However, even if it were entered, it would not appear to overcome the rejection. There are many potential target sites in the mammalian body. That the galactoside-polylysine-Gly residues of the Plank et al article may not bind to thrombus sites or sites of infection does not mean that the galactoside-polylysine-Gly residues will not bind to some site in the body. For example, given the presence of the galactoside, it can reasonably be expected that it will bind to galactose receptors present in the liver.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey E. Russel at telephone number (571) 272-0969. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Brenda Brumback can be reached at (571) 272-0961. The fax number for formal communications to be entered into the record is (703) 872-9306; for informal communications such as proposed amendments, the fax number (571) 273-0969 can be used. The telephone number for the Technology Center 1600 receptionist is (571) 272-1600.



Jeffrey E. Russel  
Primary Patent Examiner  
Art Unit 1654

JRussel  
April 22, 2004